

REMARKS

The Application has been reviewed in light of the Office Action mailed April 4, 2006. Claims 1-6, 8-12, and 14 were pending. Claims 1-6 stand rejected under 35 U.S.C. § 102(b) and Claims 4, 5, 8-12 and 14 stand rejected under 35 U.S.C. § 103(a). Claim 1 has been amended to further define various features of Applicant's invention. Claims 21-26 have been added. Applicant respectfully requests favorable action for all pending claims.

Rejections under 35 U.S.C. § 102

Claims 1-6 were rejected in the Office Action under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 3,410,474 issued to C.C. Keil ("Keil"). Keil discloses protective corner pads for use in packaging consisting of three modules designed to be mates. (Col. 2, lines 57-58).

With respect to independent Claim 1 as amended to correct an informality, Applicant respectfully traverses the anticipation rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Keil does not anticipate Claim 1 as amended, because Horst does not show all elements of Claim 1. Keil, for example, fails to disclose, either expressly or inherently, "[a] packing support comprising a *top section and a bottom section*" and "at least three detachable joints formed in the packing support, the *at least three detachable joints operably detachable to cause the top section to separate from the bottom section*," as specifically recited in Claim 1. The Office Action asserts that "Keil discloses a packing support with a top section **2 & 16** and a bottom section **18** with at least three detachable joints **12/14** operable detachable to cause the top section to separate from the bottom section." (Office Action, Page 3) (emphasis in original).

Keil discloses a protective corner pad used in packing comprising three "modules." (Col. 1, lines 29-31; Col. 2, lines 57-58). "[T]he tongue **14** of one module fits nicely the

groove **12** of a second module; the tongue of such second module will fit closely in the groove of the third module, with the tongue of the groove of the latter being so sized as to fit closely in the groove of the first module.” (Col. 2, lines 58-63) (emphasis in original).

Accordingly, if as asserted by the Office Action, the modules 2 and 16 can be properly equated to a “top section” and the module 18 can be properly equated to a “bottom section” (which such equivalence is not conceded by Applicant), such top section and bottom section would be connected to each other by only two joints (that is, module 18 is connected at one joint to module 2 and by another joint to module 16). In contrast, independent Claim 1 recites at least three detachable joints between the top section and the bottom section of the claimed packing system. Thus, Keil does not teach, either expressly or inherently, the packing system recited in Claim 1. Keil fails to disclose the recited limitations, and therefore, cannot anticipate Claim 1.

Given that Claims 2-6 depend from Claim 1, Applicant respectfully submits that Claims 2-6 are also not anticipated by Keil. As such, Applicants respectfully request that the Examiner reconsider and withdraw the 35 U.S.C. § 102(b) rejections of Claims 1-6.

Rejections under 35 U.S.C. § 103

The Office Action rejected Claims 4 and 5 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Keil. The 35 U.S.C. § 103(a) rejection is improper because the cited references fail to teach or suggest all of the claimed limitations.

The Office Action states that “Claims 4 and 5 are product-by-process claims. Keil, as applied to Claim 1 above discloses the claimed structures. ... If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” (Office Action, Page 3). However, for the reasons stated above with respect to the rejection under 35 U.S.C. § 102(b), Keil does not teach, either expressly or inherently, “[a] packing support comprising a top section and a bottom section” and “at least three detachable joints formed in the packing support, the at least three detachable joints operably detachable to cause the top section to separate from the bottom section,” as recited in Claim 1 and incorporated by

reference in Claims 4 and 5. Therefore, Applicants request reconsideration, withdrawal of the rejections under 35 U.S.C. § 103(a) and full allowance of Claims 4 and 5.

Claims 8-12 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Prior Art Figure 1 (“PA1”) of the instant application in view Keil. Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Independent Claim 8 recites an information handling system packaged for shipping that includes, among other limitations, detachable container supports having a first section and a second section, where “at least three joints formed in the container support, the at least three joints operably detachable to cause the container support to separate into the first section and the second section.”

As discussed above, there is no disclosure within Keil of including an additional (third) joint between the asserted top section (modules 2 and 16 of Keil) and the asserted bottom section (module 18 of Keil) of the protective corner pad. Additionally, the packaging materials taught by Keil fail to disclose, teach or suggest a detachable joint that allows a top section of a packing support to be removed such that an information handling system can be removed from a box while the bottom section of the packaging support remains in the box, as recited in Claim 8. Additionally, the Office Action’s assertion that “Keil shows that a corner-type support system that only receives a portion of the retained product was an equivalent

structure [to the claimed top-to-bottom support] known in the art” (Office Action, Page 4) is incorrect because no portion of Keil discloses that the shock-absorbing qualities or other qualities of the protective corner pad contemplated by Keil are equivalent to the claimed packing system, nor is such asserted equivalence otherwise disclosed in Keil.

Further, PA1 fails to disclose, teach or suggest providing a packaging system with at least three detachable joint or providing the claimed detachability.

Accordingly, Keil and PA1, taken together or independently, fail to disclose, teach or suggest the information handling system recited in Claim 8. Keil and PA1 fail to disclose, teach or suggest the recited limitations, and therefore, cannot anticipate Claim 8.

Given that Claims 9-14 depend from Claim 8, Applicant respectfully submits that Claims 9-14 are allowable. As such, Applicants respectfully request that the Examiner reconsider, withdraw the rejections under 35 U.S.C. § 103(a) and allow Claims 8-14.

New Claims

New claims 21-26 have been added. New claim 21 is patentable over the cited references because the cited references do not teach or suggest an breakaway apparatus including a first upper packing support to receive first and second corners of a system and a first lower packing support to receive third and fourth corners of the system where the first upper and lower packing supports define a set of at least three detachable joints for affixing detachably and reuseably the first upper packing support to the first lower packing support. Claims 22 - 26 provide additional and patentable refinements of the apparatus recited in claim 21.

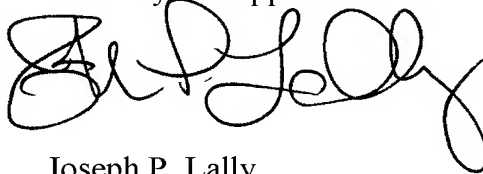
CONCLUSION

Applicant appreciates the Examiner's careful review of the Application. Applicant believes that this case is in condition for allowance. Applicant respectfully requests reconsideration and allowance of all pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2680.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants

A handwritten signature in black ink, appearing to read 'J. P. Lally', with a stylized, flowing script.

Joseph P. Lally
Registration No. 38,947

Date: July 5, 2006

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **23640**

512.322.2680

512.322.8359 (fax)